

PATENT

ATTORNEY DOCKET NO: 13801US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Graham, Brian et al	Art Unit: 1633
Serial No: 10/531,531	Examiner: Kelley, Robert M.
Filed: December 19, 2005	
For: PROCESS FOR TREATING NON-HUMAN ANIMALS	

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

PETITION TO REVIVE ABANDONED PATENT APPLICATION UNDER MPEP §1.137(b)

I. BACKGROUND

By paper dated 08/05/2009 (Copy attached as Exhibit A), Examiner Kelley notified Applicants that the above-identified Application was abandoned because Applicants failed to file a "bona fide" response to Examiner's Notice of Non-Compliant Amendment (37 CFR §1.121) dated 03/03/2009. As explained below, Applicants' attorney Patricia Coburn made a bona fide effort to file a timely, compliant response to the Notice of Non-Compliant Amendment dated 03/03/2009. However, despite Attorney Coburn's good faith efforts to find and correct all marking errors in the claims listed in the Request for Continued Examination and Preliminary Amendment dated 11/22/2008 ("RCE") (Exhibit B) in order to provide a compliant response, there was an error in marking of one claim out of 43 claims pending in the Application. Attorney Coburn failed to underline five (5) added words in Claim 11.

II. REQUEST FOR REVIVAL

Applicants hereby requests that the Director revive USSN 10/531,531, and cause Examiner to enter the attached corrected Response to Notice of Non-Compliant Amendment (Exhibit B) so that prosecution may continue in this Application. The facts set forth below support Applicants' representation that a bona fide effort was made to file a compliant Response to Examiner's Notice of Non-Compliant Amendment dated 03/03/2009 and that Attorney Coburn's failure to properly mark Claim 11 was unintentional and inadvertent. Because Examiner considered Attorney Coburn's failure to correctly mark Claim 11 as being a non-bona-fide response to the Notice of Non-Compliant Amendment, Examiner caused USSN 10/531,531 to go abandoned. Accompanying this Petition is the petition fee set forth in MPEP §1.17(m).

III. UNDERLYING FACTS

Attorney Coburn received USSN 10/531,531 for prosecution from Battelle, the assignee of this Application, after Battelle's receipt of an Office Action marked Final dated 02/28/2008. Neither Battelle nor Attorney Coburn had access to an electronic (WORD) copy of the previous Response filed pursuant to 37 CFR §1.111, nor did they have a WORD copy of the specification and claims as originally filed. In order to avoid having to retype the claims and to reduce the cost of preparation of the response, Ms. Coburn took the following action:

1. She obtained a copy of the claims as originally filed from US 2006/0179491 A1 which was retrieved using the Delphion data base (Delphion is a product of Thomson Reuters);
2. The original claims from the Delphion listing were prepared by removing hyper-links, underlining and blue font color;
3. The claims from Step 2 were marked-up to conform to the claims listed in the Response dated 12/03/2007;
4. The claims from Step 3 were changed to enter the amendments made in the Response dated 12/03/2007; and
5. The claims from Step 4 were marked-up to reflect amendments made to the claims as listed in the Amendment and Response Under 37 CFR §1.116 dated 08/28/2008.

A Request for Continued Examination and Preliminary Amendment (RCE) was filed on 10/22/2008 in order to gain time to discuss the subject matter of USSN 10/531,531 with scientists from Battelle. The listing of claims in the Response to Final was used to prepare the listing of claims in the RCE.

Examiner issued a Notice of Non-Compliant Amendment dated 11/03/2008. The error complained of was Attorney Coburn's failure to list all of the previously cancelled claims in the listing of claims. A Response to the Notice of Non-Compliant Amendment dated 12/03/2008 was timely filed to list all cancelled claims which had ever been pending in the Application.

By paper dated 03/03/2009, Examiner issued a second Notice of Non-Compliant Amendment stating that "at least Claim 30 is improperly marked". At this time, Attorney Coburn reviewed all of the amended claims and found that in addition to Claim 30, Claims 3, 11, and 22 were also improperly marked. A Response to Notice of Non-compliant Amendment dated 03/26/2009 showing a complete listing of the claims as well as the correctly marked claims was timely filed.

Despite Attorney Coburn's careful comparison of the amended claims in the Response to Final (37 CFR §1.116) dated 08/28/2008 versus the listing of claims in the Response to Office Action (37 CFR §1.111) dated 12/03/2007, the correction to Claim 11, was incomplete and underlining was omitted from the words, "said liquid carrier vehicle contains". Shown below is Claim 11 with the incorrect marking and Claim 11 as it should be marked.

Improperly Marked Claim 11

Claim 11 (currently amended): The method ~~process~~ of claim ~~66~~ 10, wherein the ~~formulation~~ said liquid carrier vehicle contains ~~comprises~~ a surfactant dissolved or suspended therein.

Properly Marked Claim 11

Claim 11 (currently amended): The method ~~process~~ of claim ~~66~~ 10, wherein the ~~formulation~~ said liquid carrier vehicle contains ~~comprises~~ a surfactant dissolved or suspended therein.

By paper dated 08/05/2009, Examiner issued a third Notice of Non-Compliant Amendment wherein the Application was abandoned by Examiner on the grounds that a non-bona-fide response to the Notice of Non-Compliant Amendment dated 03/03/2009

was filed by Applicants. Attorney Coburn's failure to insert the above described underlining in Claim 11 was cited by Examiner as evidence that the Response filed by Applicants dated 03/26/2009 was non-bona-fide. Based on this, Examiner caused the Application to go abandoned.

IV. FAILURE TO FILE COMPLIANT RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT WAS UNINTENTIONAL

In retrospect, given careful review and inspection of the claims by Applicants' attorney, it is surprising that the lack of complete underlining in Claim 11 was not caught and corrected. However, as outlined in Section III above, many operations were made to the claims creating a familiarity that may have led Applicants' attorney to fail to see the missing underlining.

Attorney Coburn admits that she made the complained of errors. However, the abandonment of the Application by Examiner is a very harsh punishment for Attorney Coburn's innocent, inadvertent errors. There was certainly no attempt by Applicants or Ms. Coburn to mislead the Examiner and Applicants believe that Examiner was not misled in any way.

The current method of marking and listing claims in an application has been in effect for about five years which, in the history of the patent system, is a relatively short time span. The method of marking a claim is a matter of form and not of substantive patent law. Failure by an applicant or his attorney to comply with a matter of "form" should properly carry a "consequence"; however, loss of valuable property rights exalts form over substance and is a draconian punishment for unintentional errors in marking.

The initial mistakes in marking amendments to the claims occurred in Applicants' Response to Final Rejection dated 08/28/2009. When the RCE was prepared, the listing of claims was "cut" from the Response to Final and "pasted" in the RCE. Applicants were unaware that there were errors in the marking of the claims until receipt of the Notice of Non-Compliant Amendment dated 03/03/2009. Applicants made a good faith effort to correct all of the mistakes in marking in their response dated 03/26/2009 and Examiner was advised that improper marking had been found in Claims 3, 11, and 22 and that it had been corrected. Unfortunately, all of the improper marking (lack of underlining) was not corrected in Claim 11. Failure to catch all of the improper marking in claim 11 was a mistake but it was an inadvertent, unintentional mistake.

V. COMPLIANCE WITH 37 CFR §1.137(b)

Accompanying this Petition are the following items required by 37 CFR §1.137(b):

(1) The reply required to the notice. The “reply” is the corrected Response to Notice of Non-Compliant Amendment attached as Exhibit B.

(2) The Petition Fee as set forth in §1.17(m). The fee in the amount of \$1620.00 accompanies this Petition.

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The filing of this Petition was filed within 30 days of receipt of the Notice of Abandonment. The statement presented in section IV herein supports Applicants’ contention that the Response to Non-Compliant Amendment dated 03/26/2009 was prepared and filed in good faith with no intent to deceive or mislead the Examiner and that Applicants failure to correct all of the improper marking in Claim 11 was inadvertent and unintentional. Therefore, Applicants response was bone fide and as a result, the Application was improperly abandoned by Examiner.

(4) Any terminal disclaimer required pursuant to paragraph (d) of this section. No terminal disclaimer is required in this case.

Applicants hereby request that the Director revive USSN 10/531,531, and enter the attached corrected Response to Notice of Non-Compliant Amendment dated 03/26/2009 in order that prosecution may continue in this Application.

Respectfully submitted,

By: /Patricia A. Coburn/

Name: Patricia A. Coburn

Reg. No. 28,594

Date: September 8, 2009

(614)766-9136

Petition To Revive Abandoned
Patent Application Under MPEP §1.137(b)
Dated 09/08/2009

Exhibit A

Notice of Non-Compliant Amendment Dated 08/05/2009 (4 pages)
Inserted behind This Page

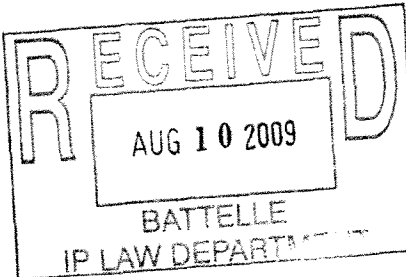


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,531	12/19/2005	Brian Graham	13801US	9102

24116 7590 08/05/2009
BATTELLE MEMORIAL INSTITUTE
505 KING AVENUE
COLUMBUS, OH 43201-2693



EXAMINER

KELLY, ROBERT M

ART UNIT	PAPER NUMBER
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1633

MAIL DATE	DELIVERY MODE
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08/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of Abandonment

Application No.

10/531,531

Examiner

ROBERT M. KELLY

Applicant(s)

GRAHAM ET AL.

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 03 April 2009.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☒ A reply was received on 03 April 2009 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

See continuation sheet below.

/Robert M Kelly/
Primary Examiner, Art Unit 1633

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

As noted in the notice of non-compliant amendment of 3/3/09, the third non-compliant amendment has herein been considered non-bone-fide. It is noted, as stated in the notice of non-compliant amendment of 3/3/09, the previously entered amendment is that 12/7/07. At least Claim 11 has remained serially-improperly-marked. Claim 11, as last entered, in the amendment of 12/7/07, recited "The process of claim 10, wherein the formulation comprises a surfactant." The non-entered amendment of 8/28/08 recited "The method of claim 66, wherein said liquid carrier vehicle contains a surfactant dissolved or suspended therein.", wherein the limitations of "said liquid carrier vehicle contains" and "dissolved or suspended therein." are not underlined. The non-entered amendment of 12/3/08 repeats the same incorrect markings. The non-entered amendment of 4/3/09, while being amended the same, does provide underlining for "dissolved or suspended therein." but fails to provide underlining for "said liquid carrier vehicle contains". In each notice of non-compliant amendment for the non-entered amendments of 8/28/08 and 12/3/08 (the notices of 10/23/08 and 3/3/09), the Examiner specifically warned Applicant that the claims were not thoroughly checked due to the sheer number of claims and the fact that to enter the claims would force the Examiner to make of record the proper markings in each instance, and that it is not the Examiner's duty to do so, but Applicant's duty. In addition, the last notice of non-compliant amendment warned Applicant that a third non-compliant amendment would force abandonment as being non-responsive. Herein, at the very least, Claim 11 has been serially improperly marked for the same reasons. Hence, this application is properly abandoned for non-bone-fide response.

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/531,531

Examiner

ROBERT M. KELLY

Applicant(s)

GRAHAM ET AL.

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 03 April 2009 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: _____
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or
Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Exhibit B

Response to Notice of Non-Compliant Amendment (11 pages)
Inserted Behind this Page